

REMARKS

This paper responds to the Office Action mailed on May 2, 2007. Claims 40, 41, 46 and 47 are amended and claims 44, 45 and 48 are canceled such that claims 40-43 and 46-47 are now pending in this application. Support for the amendment to claim 40 is found in FIGS. 1, 2 and 6 of Applicant's specification.

Interview Summary

Applicant thanks Examiner Isis A. Ghali for the courtesy of a telephone interview held on May 15, 2007, with Applicant's representative Andrew R. Peret. Examiner Ghali and Applicant's attorney discussed the pending 35 U.S.C. § 112, second paragraph, rejection.

Examiner Ghali agreed to withdraw the pending 35 U.S.C. § 112, second paragraph, rejection in view the amendment to claim 40. In addition, Examiner Ghali indicated that the amendment to claim 40 may overcome the pending 35 U.S.C. § 102 rejection.

Applicant further notes that as part of the Examiner Interview Summary which was mailed May 22, 2007, the Examiner states "Mr. Peret indicated that the container is the novel element of the present invention as it makes it convenient to the consumer to buy three elements in one box." Applicant respectfully traverses this assertion in part because as discussed during the interview, '358 does not teach or suggest "a container that includes at least one compartment" in combination with "wherein the first patch, the second patch and the flexible wrap are all within the same compartment in the container" as recited in amended claim 40.

Double Patenting Rejection

Claims 32-62 were rejected under a non-statutory double patenting rejection, specifically claims 1-39 of copending Application No. 10/954,764 in view of 5,751,510. Applicant does not admit that the claims are obvious in view of the claims 1-39 of copending Application No. 10/954,764 in view of 5,751,510. Applicant will consider whether filing a Terminal Disclaimer is appropriate when all claims are indicated to be otherwise allowable and if some overlap arises between the subject matter of the present application and the allowed claims of those other applications.

First §112 Rejection of the Claims

Claims 40-48 were rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description or enablement. Applicant respectfully traverses these grounds for rejection. As described in MPEP § 2164 et seq., the following represents the *prima facie* case that the Examiner must provide in order to maintain a rejection of nonenablement with respect to the disclosure of a patent application under 35 U.S.C. § 112, first paragraph:

1. a rational basis as to
 - a. why the disclosure does not teach, or
 - b. why to doubt the objective truth of the statements in the disclosure that purport to teach;
2. the manner and process of making and using the invention;
3. that correspond in scope to the claimed invention;
4. to one of ordinary skill in the pertinent technology;
5. without undue experimentation; and
6. dealing with subject matter that would not already be known to the skilled person as of the filing date of the application.

Since the Examiner has not provided evidence supporting each of these elements, the Examiner has not made out a *prima facie* case for nonenablement under 35 U.S.C. § 112, first paragraph. Applicant notes in particular that the Examiner has not outlined what would not be known to one of ordinary skill in the art.

Applicant further notes that the Examiner acknowledges at page 4 of the Office Action that “the relative skill of those in the art is high.” Therefore, Applicant does not understand the Examiner’s discussion in the rejection related to transdermal delivery of medications (i.e., as related to claim 42) because as discussed in the rejection, the transdermal delivery of medications depends on many factors (which would be known to one of ordinary skill in the art).

Further, applicant respectfully submits that the specification does provide enablement commensurate with the scope of claims 40-43 and 46-47. Applicant respectfully directs the Examiner’s attention to FIGS. 1, 2 and 6 and the specification at page 4, line 20 through page 5, line 16 and at page 7, lines 12-32. These portions of the figures and specification, among others, enable a person of ordinary skill in the art to make and use the invention commensurate with the scope of claims 40-43 and 46-47.

Reconsideration and/or allowance of claims 40-43 and 46-47 are respectfully requested.

Second §112 Rejection of the Claims

Claims 40-48 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. As discussed during the interview, Applicant has amended claim 40 to remove the expression “near the portion of the body” and the Examiner indicated that this amendment would overcome the pending 35 U.S.C. § 112, second paragraph, rejection.

§102 Rejection of the Claims

Claims 40, 41, and 43-48 were rejected under 35 U.S.C. § 102(b) for anticipation by U.S. Patent No. 4,592,358 (hereafter ‘358). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P.* ‘2131. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. V. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As discussed during the interview, ‘358 does not teach or suggest “a container that includes at least one compartment” in combination with “wherein the first patch, the second patch and the flexible wrap are all within the same compartment in the container” as recited in amended claim 40.

Applicant further notes that the therapeutic device 10 disclosed in ‘358 only describes holding cooling OR heating packets (see ‘358 at col. 3, line 12, 27, 37). Therefore, Applicant respectfully submits that ‘358 does not teach or suggest that the first and second patches which are within the therapeutic device 10 at the same time apply different types of therapy as recited in claim 40. In addition, Applicant respectfully submits that ‘358 does not teach or suggest “a third patch held by said holder, wherein said third patch applies a third therapy . . . , the third therapy being different than the first and second therapies, wherein the first patch, the second patch, the third patch and the flexible wrap are all within the same compartment in the container” as recited in amended claim 41.

Reconsideration and/or allowance of claims 40, 41, 43 and 46-47 are respectfully requested.

§103 Rejection of the Claims

Claim 42 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,592,358 in view of 6,245,347 (hereafter '347). Applicant respectfully traverses the rejection because the combination of '358 and '347 does not describe each and every element of the claimed invention, and combining '358 with '347 by altering the '358 to include a control apparatus 100 as disclosed in '347 would destroy the stated purpose of '347.

I. '358 and '347 do not teach or suggest every element of claim 42

As discussed during the interview, '358 does not teach or suggest "a container that includes at least one compartment" in combination with "wherein the first patch, the second patch and the flexible wrap are all within the same compartment in the container" as recited in amended claim 40. Applicant further notes that there does not appear to any disclosure in '347 related to a holder or container that secures the disclosed patches. Therefore, Applicant respectfully submits that combination of '358 and '347 does not teach or suggest first and second patches which are within the same compartment in a container at the same time and are able to apply different types of therapy as recited in claim 40.

Applicant notes that claim 42 depends from claim 40, and as such incorporates all of the limitations of claim 40. Therefore, Applicant respectfully submits that the combination of '358 and '347 does not teach or suggest a system as recited in claim 42.

II. Combining '358 and '347 would destroy the stated purpose '347

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01.

Combining '358 with '347 by altering the '358 to include a control apparatus 100 as disclosed in '347 would destroy the stated purpose of '347 which is the "**administration of**

drugs.” (See ‘347 at column 3, lines 54-56). Applicant notes that placing the apparatus 100 into the compartments 12 of ‘358 would not allow the apparatus 100 to deliver drugs because the apparatus 100 would not engage the skin (which is required for the apparatus 100 in ‘347 to function properly).

Since combining ‘358 with ‘347 would destroy the stated purpose of ‘347, the rejection should be withdrawn. Reconsideration and allowance of claim 42 are respectfully requested.

RESERVATION OF RIGHTS

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant’s silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner’s personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (262) 646-7009 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date June 6, 2007

By / Andrew Peret /
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 6th day of June 2007.

CANDIS BUENDING

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